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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,222	08/19/1999	JEFFRY JOVAN PHILYAW	PHLY-24.670	8863

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EXAMINER
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THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 10/22/2003

27

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/378,222	PHILYAW ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Marc D. Thompson	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 9 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. Amendment E, Paper #26, received 8/1/2003, has been entered into record.
2. Claims 1-20 remain pending.

***Priority***

3. This application is a continuation-in-part of Patent Number 6,098,106, previously pending application number 09/151,530.
4. The effective filing date for the subject matter defined in the pending claims which was disclosed in the parent application is 9/1/1998. All new matter disclosed in the present application and expressed in the claims is entitled to an effective filing date of 8/19/1999.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).
7. Claims 1-8, 10-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. (U.S. Patent Number 5,905,865), hereinafter referred to as Palmer, in view of Watanabe (U.S. Patent Number 6,163,803), hereinafter referred to as Watanabe.

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8. Palmer disclosed the invention substantially as claimed. Palmer disclosed the synchronizing of additional, related network retrieved data with digitally stored or received video and audio data. See Column 6, Lines 47-64. This retrieved information was enacted using Internet connection manipulation without human interaction, i.e. automatically. See Column 6, Lines 3-6, and Column 7, Lines 7-12. Palmer disclosed both combination of network locators in the actual video/audio signal, out of band broadcast of locators, and transmission of locators from remote sites. See Column 1, Lines 60-67, Column 2, Lines 25-33, Column 5, Lines 22-43, Column 5, Lines 59-62, and Column 8, Lines 5-19. Palmer also disclosed the use of an “intermediate node” (in the network) which received and redirected URL requests to the appropriate server(s) and compared decisions with the contents of user profiles. See Column 5, Lines 44-62, and Column 7, Lines 28-45. As discussed below (response to arguments), the URL designations were additionally resolved by DNS servers on the network in order to result in a physical address of a network device for information retrieval. The “playing”, “detecting”, and “assembly” of the provided information embedded within multimedia information was substantially described by Palmer in sufficient detail to enable one of ordinary skill in the art to implement the invention as broadly claimed.

9. While Palmer substantially disclosed the embedding of unique resource locators (URLs) (routing information) in a digital stream of network transmitted data (Column 5, Lines 59-62), Palmer remained silent as to the specifics which would have been required to enact this type of functionality. Embedding of network locator (routing information) designations in the streamed data was mentioned as an alternate embodiment to achieve the feature of network resource and remote information synchronizing with stored or delivered digital data.

10. In the art of network resource encoding, Watanabe disclosed a method and system for encoding network resource locators into stored and delivered digital data for display of remotely stored related information. See Column 4, Lines 28-55. Watanabe also disclosed the embedding/encoding of network resource designators specifically with audio signals, and the extraction of the network designators during playback of the audio information. See Column 6, Lines 8-26, and Column 9, Lines 53-56. The URL signal(s) were disclosed as part of the audible signal, resulting in a “perceivable tone”, *alternatively/preferably* hidden from listener detection. See Column 6, Lines 59-65, and Column 7, Lines 44-49. The system also automatically retrieved the data according to the specified designator(s). See Column 9, Lines 36-42.

11. Incorporation of the Watanabe teachings into the teachings of Palmer would have been obvious to one of ordinary skill in the art for the simple reason that recited functionality drawn to the embedding of URL routing information into an audio stream or recording was fully described in such a way to enable the ordinary artisan to implement it. That is, the embedding of URL routing information and overall functionality drawn to delivery of audio/video associated/related information which was remotely stored provided by Palmer in Column 5, Line 59 through Column 6, Line 29, was fully described in detail in Watanabe, Column 4, Lines 28-55. The systems of Palmer and Watanabe were so similar, that practically identical synopsis of the inventions functionality regarding the inclusion of automatically retrieved Internet information to audio/video information were found in Palmer, Column 7, Lines 7-19, and Watanabe, Column 9, Lines 36-42.

12. Thus, since the teachings contain direct suggestion for combination, an individual one of the teachings would have resulted in an ordinary artisan being motivated to search the related

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arts, that is, the inventions being drawn to the same concept of associated Internet information delivery related with audio/video digitally stored/transmitted information, and implement a detailed description of encoding informational parameters in multimedia information for remote information retrieval. Thus, combination of the teachings would have been obvious to one of ordinary skill in the art at the time the invention was made.

13. Since, all limitations recited in claims 1-8, 10-17, and 19-20, were disclosed by the combination of Palmer and Watanabe, claims 1-8, 10-17, and 19-20 are rejected.

#### ***Claim Objections***

14. Claims 9 and 18 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. It has been previously asserted, numerous times, that the detail of the system component interaction of the recited functionality set forth in this claim is sufficient to distinguish over the prior art of record.

15. Examiner notes Applicant has had numerous opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language, as suggested. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP §2111. Applicant employs broad language which includes the use of words and phrases which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth

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allows multiple interpretations and meanings which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Response to Arguments***

16. The arguments presented by Applicant in the response, Amendment E, Paper #26, received on 8/1/2003, are not considered persuasive. Applicant argues:

a. "Palmer [did not] disclose a system in which all data transfers or interactions between nodes occur over a single network." See Response, Amendment E, Paper #26, *inter alia*, Page 8, Lines 15-21. Examiner notes that the previously submitted an examined claim(s) did not explicitly specify multiple networks, nor did the claims describe a distinction between any arbitrary network(s), nor do the claims actually recite more than one network now. It is unclear the basis for this argument, since a network is/was broadly defined as "a group of computers communicating with each other." Thus, it is unclear how computers, even if assumed to be present on two distinct networks, cannot be considered part of the same network if they are indeed communicating. To make this point more clear, if required, the term "internet", itself, was coined as short for "internetworking", which provided a logical address space which provided communication between networks. Thus, an arbitrary internet is a single logical network which spans multiple subnetworks; each subnetwork is a full fledged network in its own right. In this typical scenario, even machines on disparate networks are part of the same logical network (i.e., internet network). This argument is held not to be persuasive for the simple

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reasoning that (a) two (or more) machines actively communicating are networked (i.e., part of the same logical network), and (b) Applicant's arguments seem to infer some alternate definition of the term "network" which has not been defined in the arguments, or within the claim.

b. Applicant asserts Palmer taught away from the claimed invention since Palmer failed to disclose embedding URL information in an audio program (actually broader – the unique header code), again, in the "same" network. See, Response, Amendment E, Paper #26, Page 8, Line 22 through Page 9, Line 3. This argument is completely without merit in view of Palmer, *inter alia*, Column 5, Lines 59-62, and Column 8, Lines 16-19, combined with the resultant teachings of Watanabe, *inter alia*, Column 11, Lines 13-19. In short, Palmer expressly disclosed the embedding of URL (unique header codes) in audio signal(s), and Watanabe disclosed an express method for providing this. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, Applicant's arguments may fail to comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

c. Applicant asserts Palmer failed to teach detection of a "unique header code" during playback of an audio program at a user node". See, Response, Amendment E, Paper #26, Page 9, Lines 11-16. This functionality was expressly taught by, *inter alia*, Watanabe, Column 9, Lines 36-42. Again, without significant clarification, definition, and narrowing of interpretation



of the claimed invention, the claims are not found to distinguish over the prior art of record on this point.

d. Applicant asserts Watanabe failed to disclose the alleged shortcomings of Palmer. See, Response, Amendment E, Paper #26, Page 9, Line 17 through Page 10, Line 7. The above discussion should be clear as to where the Examiner relies when citing evidence of known subject matter in the prior art of record.

e. Applicant argues the prior art did not teach the inclusion of “perceivably embedded [information]”. See Response, Amendment E, Paper #26, Page 10, Lines 1-19. Applicant cites teachings in one piece of prior art used to support this position. This argument is not considered persuasive since disclosure of one embodiment by a particular reference/teachings did not constitute a complete disclosure of the prior art. The Wolzien reference (See Response, Amendment E, Paper #26, Page 10, Lines 10-19) described embedded information within a multimedia signal constructed so as “not to interfere with the program as displayed...” It is noted that this prior art of record was not applied, and it misrepresents the currently applied prior art. Note Watanabe, inter alia, Column 7, Lines 44-49, where express provision for concealing audible signals embedded within multimedia audio portion(s) was disclosed. The provision for selective omission of a particular feature (e.g., concealment of URL information in audio signals), described as overcome and desirable in the prior art, will not serve as a basis for distinguishing the claimed invention.

### ***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm, EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's acting supervisor, David Wiley, can be reached at (703) 308-5221. The fax phone number for the organization where this application is assigned is (703) 872-9306.

Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900, or Customer Service for Technology Center 2100 at (703) 306-5631.

MARC D. THOMPSON  
**MARC THOMPSON**  
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Art Unit 2142